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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,318	07/17/2000	David N Roundhill	500789.01	9061
27076 7590 08/30/2011 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT Columbia Center 701 Fifth Avenue, Suite 6100 SEATTLE, WA 98104-7043				
EXAMINER				
REMAY, MARK DONALD				
ART UNIT		PAPER NUMBER		
3777				
NOTIFICATION DATE		DELIVERY MODE		
08/30/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket-se@dorsey.com
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Office Action Summary**Application No.**

09/617,318

Applicant(s)

ROUNDHILL ET AL.

Examiner

Mark Remaly

Art Unit

3777

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 28-58, 71-84, 86-93 and 95-107 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☐ Claim(s) ____ is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 28-58, 71-84, 86-93 and 95-107 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

1. This application is in condition for allowance except for the following formal matters: If an application contains both interfering and non-interfering claims, a restriction requirement should be made between the two.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 28-58, 71-84, 86-93, 95-102, drawn to a system and method for generating a three dimensional ultrasound image, classified in class 600, subclass 447.
 - II. Claims 103-107, drawn to a system and method for generating a three dimensional ultrasound image without the use of a contrast agent, classified in class 600, subclass 447.
3. The inventions are distinct, each from the other because of the following reasons: If the applicant traverses the restriction requirement, depending on the reasons for the traversal, the restriction may be maintained or the traversal may be treated as a concession that the non-interfering claims should be designated as corresponding to the count.
4. A claim that does not interfere, by definition, is directed to a patentably distinct invention compared to a claim that does interfere. Leaving a non-interfering claim in an application going into an interference creates an unwarranted delay in the issuance of claims to the non-interfering subject matter. As far as the public and the Office are concerned, there is no justification for not issuing the non-interfering claims promptly. An exception exists if the claims are

Art Unit: 3777

already term limited, as would be the case for an application subject to a terminal disclaimer or a reissue application (see 35 U.S.C. 154(b)(1)(C) (referring to issuance of the original patent)).

5. The following is an examiner's statement of reasons for allowance: Applicant has persuasively argued enablement in the disclosure dating back in the priority chain to provisional application 60/032,771 with a filing date of November 26, 1996. As such, the 35 USC 112 first paragraph rejection has been withdrawn. Additionally, the 35 USC 102(e) and 35 USC 102(f) rejections have been withdrawn since the priority predates the prior art used in those rejections.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Applicant has suggested an interference pursuant to 37 CFR 41.202(a) in a communication filed 04/28/2011.

Applicant failed to provide sufficient information to identify the application or patent with which the applicant seeks an interference. See 37 CFR 41.202(a)(1) and MPEP § 2304.02(a).

Applicant failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b).

Applicant failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c).

Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c).

Conclusion

7. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Remaly whose telephone number is (571)270-1491. The examiner can normally be reached on Monday - Friday 7:30am-5:00pm, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Chen can be reached on (571) 272-3672. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3777

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Remaly/
Examiner, Art Unit 3777

/Tse Chen/
Supervisory Patent Examiner, Art Unit 3777